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In re Application of	:	DECISION ON
Certagon Ltd.	:	
PCT No.: PCT/US2005/10547	:	PETITION UNDER
Application No: 10/599,541	:	
Int. Filing Date: 29 March 2005	:	
Priority Date: 29 March 2004	:	37 CFR 1.47(a)
Attorney's Docket No.: CERT0004	:	
For: METHOD and APPRATUS for...	:	
in ENTERPRISE	:	

This is in response to the "PETITION BASED UPON UNAVAILABILITY OF INVENTOR OF INVENTOR (37 C.F.R. 47)" filed on 23 October 2007. The requisite \$200 petition fee has been paid.

**BACKGROUND**

On 29 March 2005, applicants filed international application PCT/US2005/10547, which claimed priority to an earlier application filed 29 March 2004. The thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 29 September 2006.

On 29 September 2006, applicants filed for entry into the national stage in the United States of America. Filed with the application was, inter alia, the requisite basic national fee. However, no executed declaration was filed at such time.

On 23 May 2007, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date... does not identify the citizenship of each inventor" must be submitted within two months from of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 23 October 2007, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of joint inventor Ron Wolf.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

#### **INVENTOR CANNOT BE REACHED:**

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.

The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.

Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied items (1) and (4) of 37 CFR 1.47(a). However, items (2) and (3) have not been satisfied.

Regarding item (1), the correct petition fee of \$200.00 has been charged to petitioner's Deposit Account No.: 07-1445.

Regarding item (2), the averments of Mr. Glen are insufficient to support a finding that the nonsigning inventor, Mr. Wolf could not be located after diligent effort. Mr. Glenn's declaration fails to show diligent effort to locate inventor Mr. Wolf because he broadly states that "Applicant has tried several times to contact inventor wolf via his last known number," which does not show effort to locate the missing inventor. For example, he has not searched for the above non-signing inventor's new address by using a broad search in the internet and a phone directory listing, which would show diligent effort by him to find the nonsigning inventor.

Moreover, it is not clear from the petition that it was Mr. Glenn who performed the items listed in section 2 of the petition, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Glenn was not the person who performed the actions listed in that section, petitioner will need to submit statements, with specific facts on the actions referred to by section 2 by persons who have first-hand knowledge of such facts

Regarding item (3), petitioner has not provided a statement of the last known address of the missing inventor.

Consequently, at this time it can not be concluded that the nonsigning Mr. Wolf could not be found after diligent effort.

### **CONCLUSION**

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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